

REMARKS

Claims 1-30 are pending in the application. Claims 1, 5, 8, 11, 14, 18, 21, 24, and 27 are independent. No claims have been amended, canceled, withdrawn, or added. The Abstract has been amended. It is believed that these changes introduce no new matter and there entry is respectfully requested.

Objection to the Specification

In paragraph 1 Office Action, the Examiner objected to the Abstract stating that the Abstract is simply a recitation of the claims and required correction. Applicants have amended the Abstract to accommodate the objection and respectfully request that the Examiner reconsider and remove the objection to the Abstract.

In paragraph 2 Office Action, the Examiner objected to the disclosure stating that a Summary is missing and required correction. Applicants would like to kindly point out that both the MPEP and 37 CFR §1.73 do not require the presence of a “Summary of the Invention” in a patent application. They merely indicate where in the application the “Summary of the Invention” should be placed if the Applicants were to elect to include one. In particular, 37 CFR §1.73 only states that “[a] brief summary of the invention ... should precede the detailed description.” 37 CFR § 1.73 does not state “must” or “shall.” Accordingly, Applicants have elected not to include a “Summary of the Invention” as this is within the discretion of Applicants and respectfully request that the Examiner reconsider and remove the objection to the disclosure.

Rejection of Claims 1-30 Under 35 U.S.C. §103(a)

In paragraph 4 of the Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,085,159” to Ortega et al. (hereinafter “Ortega”) in view of U.S. Patent No. 6,456,972 to Gladstein et al. (hereinafter “Gladstein”). To establish a *prima facie* case of obviousness, an Examiner must show three things: (1) that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention, (2) that there must be a reasonable expectation of success, and (3) that the references teach or suggest each and every element of the claimed invention. MPEP §2143. In making a determination that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention the Examiner cannot propose a

modification that would make a reference unsatisfactory for its intended purpose or change its principle of operation. MPEP §2143.01. References cannot be combined where references teach away from their combination. MPEP §2145X.D.2. Applicants respectfully traverse the rejection.

Representative independent claim 1 recites in pertinent part “associating at least a part of said bounded region with a color, *wherein said color is used to indicate that the process is speech-enabled*” (emphasis added). In the Office Action, the Examiner concedes that Ortega fails to teach “indicating the speech enabled processes by color,” states that Gladstein “suggests using color in an enable command list to clarify the choices,” and concludes that it would have been obvious to modify the system of Ortega to indicate the speech enabled processes by using color as taught by Gladstein because it would allow deciphering and displaying of all the commands not only the speech enabled commands. Applicants respectfully disagree.

Ortega appears to be directed to a speech application that displays voice commands with multiple variables. The problem addressed in Ortega is that listing all of the voice commands that a user can say in a window clutters the window. The solution proposed in Ortega is instead of listing each and every possible version of each command, the screen displays a high-level command along with the number of variables for the command is displayed between delimiters after the command. In this way, if there are twenty variables for a command, a user does not see all twenty variables, but merely the fact that twenty variables exist.

Gladstein appears to be directed to a graphical user interface for operating multiple speech-recognition systems. The problem addressed in Gladstein is that the different speech-recognition systems have different grammar of valid vocabulary and usage and a user may not know which commands may be spoken and recognized by which application. A user may try to say something that is not defined in the grammar. The solution proposed in Gladstein is a “what can I say” dialog box that is only temporarily displayed when invoked by a user. To invoke the dialog box, a user enters via keyboard the beginnings of a sentence or a word and the dialog box lists all the individual words that begin with the letters entered via the keyboard.

Applicants respectfully submit that it would not be obvious to combine Gladstein with Ortega because to do so would make Ortega unsatisfactory for its intended purpose. For

example, Ortega is attempting to *reduce the number* of voice commands displayed. Ortega is not interested in displaying all speech-enabled commands. In contrast, Gladstein *displays all* of the words in both dictation and the Application grammar that begin with the letters entered.

Combining Gladstein with Ortega would thus make Ortega unsatisfactory for its intended purpose, which is to reduce the number of voice commands displayed. This is amplified by the fact that Ortega also teaches away from such a combination with the admonition at column 1, lines 14-15 that “listing all these voice commands in a window would clutter the window.”

Moreover, the Examiner’s rationale that modifying Ortega with Gladstein would allow deciphering and displaying of all the commands not only the speech enabled commands also is in contradiction with Ortega’s teachings because Ortega warns against displaying of all the commands.

Because combining two references in a manner that makes one or both unsatisfactory for its intended purpose is not sufficient to make out a *prima facie* case of obviousness, Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness with respect to the claimed invention and Ortega in view of Gladstein. Additionally, because combining Ortega teaches away from its combination with Gladstein Applicants respectfully submit that the Examiner again has failed to make out a *prima facie* case of obviousness with respect to the claimed invention and Ortega in view of Gladstein. Because the Examiner has failed to make out a *prima facie* case of obviousness with respect to the claimed invention and Ortega in view of Gladstein Applicants respectfully submit that the claimed invention is patentable over Ortega in view of Gladstein. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection of claims 1-30.

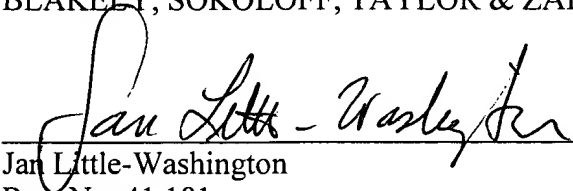
CONCLUSION

Applicants submit that all grounds for rejection have been properly traversed and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 12/22/04


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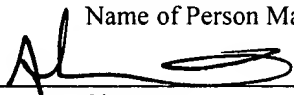
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